

JUL 05 2006

Serial No. 10/717,988
60130-1967; 01MRA0218**REMARKS**

Applicant has filed an Information Disclosure Statement relating to the United Kingdom Search Report with the response.

The drawings are objected to under 37 CFR 1.83(a) as not showing every feature of the invention specified in the claims. Claim 10 has been amended to remove the language relating to the "fourth semi-rigid tube." No new drawings are needed.

The abstract is objected to because the method of assembling the window regulator assembly is not specifically set forth. The abstract has been amended to recite the method.

The title of the invention is objected to as not being descriptive. The title has been amended to refer to the method.

Claims 1, 2, 6 and 12 are rejected under 35 U.S.C. 103(a) as being obvious over Tatsumi et al (US 2002/0053168). The Examiner states that Tatsumi fails to specifically disclose the claimed method steps, but states that Tatsumi would inherently lead to the method steps set forth in the claimed invention. Applicant respectfully disagrees.

The claimed invention is not obvious. There is no teaching, suggestion or disclosure in Tatsumi of a method for providing a window regulator cable assembly that includes a semi-rigid tube subject to an axial load to maintain tension in a cable arrangement, the method including the step of mounting a subassembly on a rigid frame to remove the axial load from the semi-rigid tube. The Examiner refers to paragraph 41 of Tatsumi. Tatsumi discloses a window regulator 3 including a cable covered with an outer tube 37 having both ends fixed to rails 7 and 9 such that the rails 7 and 9 are connected to each other by the outer tube 37. The window regulator 3 is integrated even before the window regulator 3 is assembled to the door 1. Tatsumi does not disclose how the loads in the outer tube 37 change during mounting of the window regulator 3 on the door 1. In fact, Tatsumi teaches away from the claimed invention. Because both ends of the outer tube 37 are fixed to the rails 7 and 9, there is no change in an axial load in the outer tube 37. If there was no axial load on the outer tube 37 after assembly as the Examiner contends, there would be a gap between one end of the outer tube 37 and its associated rails 7 and 9. However, this is not possible because both ends of the outer tube 37 are fixed to the rails 7 and 9. It is not possible for the outer tube 37 to be under an axial load and then have the axial load removed as claimed for this would form a gap.

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The Examiner also stated that Tatsumi inherently leads to the claimed methods. The Federal Circuit has clearly stated that inherency cannot be established simply by asserting that a certain thing may result from a given set of circumstances. To support an inherency argument, the disclosure offered by the Examiner must be "sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function" and that the missing claimed element is "necessarily present" in the reference such that it would be recognized by persons of ordinary skill. *Finnegan Corp. v. ITC*, 51 USPQ2d 1001 (Fed. Cir. 1999), quoting *In re Oelrich*, 666 F.2d 578, 212 USPQ 323 (CCPA 1981). Further, "the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic" MPEP §2112. To rely upon an inherency theory, "the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art" MPEP §2112. The Office Action has failed to meet this burden.

Finally, there is no teaching, suggestion or disclosure in Tatsumi of a cable arrangement under tension as claimed. Tatsumi does not disclose that the cable 21 is under tension and does not disclose how the tension in the cable 21 changes when it is installed in the door 1. The claimed invention is not obvious, and Applicant respectfully requests that the rejection be withdrawn.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tatsumi in view of Blankenburg et al. (U.S. Patent No. 4,216,624). Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tatsumi in view of Colanzi (U.S. Patent No. 4,171,594). Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tatsumi in view of Heckel et al. (U.S. Patent No. 5,477,641). Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tatsumi et al. in view of Marscholl et al. (U.S. Patent No. 4,984,386). Claims 4, 5, 7, 13 and 14 depend on patentable independent claim 1 and are allowable for the reasons set forth above. The claimed invention is not obvious because none of the reference disclose, suggest or teach the step of removing an axial load from a semi-rigid tube as claimed. The claimed invention is not obvious, and Applicant respectfully requests that the rejection be withdrawn.

Claims 1 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Handte et al. in view of Tatsumi. The Examiner states that Handte does not disclose a tube. The

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Examiner states that Tatsumi teaches a tube, and it is obvious to employ a tube in Ttsumi. Applicant respectfully disagrees.

Tatsumi does not disclose the step of removing an axial load from a semi-rigid tube for the reasons set forth above. Therefore, even if the outer tube 37 of Tatsumi was employed in Handte, an axial load would not be removed from the outer tube 37 when it is mounted as claimed. Neither reference teaches this feature, and therefore the claimed invention is not disclosed, suggested or taught. The claimed invention is not obvious, and Applicant respectfully requests that the rejection be withdrawn.

Thus, claims 1-14 are in condition for allowance. No additional fees are seen to be required. If any additional fees are due, however, the Commissioner is authorized to charge Deposit Account No. 50-1482, in the name of Carlson, Gaskey & Olds, P.C., for any additional fees or credit the account for any overpayment. Therefore, favorable reconsideration and allowance of this application is respectfully requested.

Respectfully Submitted,

CARLSON, GASKEY & OLDS, P.C.

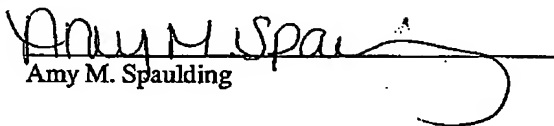


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CERTIFICATE OF FACSIMILE

I hereby certify that this response is being facsimile transmitted to the United States Patent and Trademark Office, 571-273-8300 on July 5, 2006.



Amy M. Spaulding